

the middle of page 2 of the final rejection, the Examiner professes a lack of understanding of what is intended by the term “tackiness.” In response, however, Applicants note that the Examiner himself provides a definition for the term in the last sentence on page 4 of the Final rejection. Consequently, the term has a well known definition and, therefore, its use cannot be indefinite.

With respect to the Examiner’s criticism that the specification does not contain a formal definition for this term, Applicants would remind the Examiner that, as stated by the Court in *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 231 USPQ 81, 94 (Fed. Cir. 1986), “a patent need *not* teach, and *preferably omits*, what is well known in the art (emphasis added).” Since the term “tackiness” has a well known definition, as conceded by the Examiner himself, in view of *Hybritech*, the specification need not teach, and preferably omits, such definition.

Finally, with respect to the Examiner’s criticism that it is unclear how much tackiness is decreased, Applicants submit that there is no requirement that the specification include such information. Tackiness is a matter of feel and ultimately what is important is that by following the teachings of the present invention users thereof will feel that the inventive compositions are less tacky than are compositions that do not incorporate the inventive combination of chitosans + phospholipids. The extent of such reduction is not important as any reduction in tackiness is beneficial.

In view of the foregoing, Applicants submit that the Examiner would be fully justified to reconsider and withdraw this rejection. An early notice that this rejection has been reconsidered and withdrawn is, therefore, earnestly solicited.

Claims 4-7 were rejected under 35 USC § 102(b) as being anticipated by EP 0 771 556 or Magdassi, U.S. Patent No. 5,518,736, or FR 2 667 072. As alluded to above, claims 4-7 are drawn to a method of reducing tackiness by incorporating a phospholipid into a cosmetic or dermatological preparation comprising chitosan.

Applicants previously argued that the Examiner had not shown where in these cited references the instant methods were taught. In the middle of page 3 of the final rejection, the Examiner says “[t]he differences argued cannot be determined since applicant has not provided an English translation. The reference appears to teach the stability of the composition by chitosan.”

In response, Applicants have a number of comments. First, EP 0 771 566 and Magdassi, U.S. Patent No. 5,518,736, are in English. Accordingly, no translation of these references was needed in order to ascertain the correctness of Applicants’ arguments. Applicants submit that neither of these references teaches what is presently claimed, i.e., that tackiness can be reduced by incorporating a phospholipid into a cosmetic or dermatological preparation comprising

chitosan. Accordingly, Applicants respectfully request that the Examiner immediately withdraw the rejection of claims 4-7 over these references.

Second, with respect to FR 2 667 072, an English-language translation thereof was attached to the amendment dated February 20, 2001. Applicants submit that there is no teaching or suggestion therein that tackiness can be reduced by incorporating a phospholipid into a cosmetic or dermatological preparation comprising chitosan. Accordingly, Applicants respectfully request that the Examiner immediately withdraw the rejection of claims 4-7 over this reference as well.

Third, the Examiner is apparently in agreement with this assessment already since he expressly found that the teachings of these references were limited *to stability, which is not the purpose recited in the instant claims*. The Examiner himself has not found any indication in any of these references that tackiness can be reduced by incorporating a phospholipid into a cosmetic or dermatological preparation comprising chitosan.

In view of the foregoing, Applicants submit that the Examiner would be fully justified to reconsider and withdraw this rejection. An early notice that this rejection has been reconsidered and withdrawn is, therefore, also earnestly solicited.

Claims 4-7 were rejected under 35 USC § 103(a) as being obvious over EP 0 771 556 or Magdassi, each taken individually or in combination. At the bottom of page 4 of the final rejection, the Examiner comments:

“With regard to tackiness, there is no specific definition of this term in the specification and applicant himself has not shown that the tackiness is reduced. The dictionary meaning of tackiness is ‘sticky’ and applicant has not shown that the prior art compositions are sticky. [Emphasis added.]”

In response, Applicants submit that this is an attempt to impermissibly shift the burden from the Examiner to Applicants. As the proponent of this rejection, the burden was squarely on the Examiner to make out a *prima facie* case of obviousness; only when the Examiner’s burden was carried forward did the burden then shift to Applicants to provide any proof of nonobviousness. *In re Piasecki et al.*, 223 USPQ 785, 788 (Fed. Cir. 1984). Further, absent a showing that Applicants’ allegations that the inventive compositions reduce tackiness were incredible or unduly speculative, the Examiner was required to accept these allegations as true. *In re Marzocchi et al.*, 169 USPQ 367, 369 (CCPA 1971). Thus, Applicants were not required to show that tackiness is, in fact, reduced or that the prior art compositions are sticky. Instead, the burden was on the Examiner to show that the prior art taught or suggested that tackiness could be reduced by incorporating a phospholipid into a cosmetic or dermatological preparation comprising chitosan. Since the Examiner has not made such a showing, Applicants submit that the rejection is not substantiated and should be withdrawn. An early notice that this rejection has

been reconsidered and withdrawn is, therefore, also earnestly solicited.

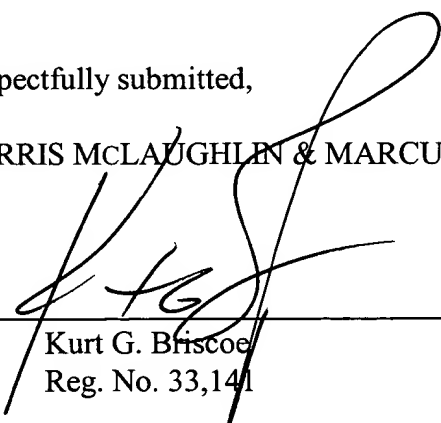
Claims 4-7 were rejected under 35 USC § 103(a) as being obvious over FR 2 667 072 alone or in combination with EP 0 771 556. In response, the arguments made above in response to the first obviousness rejection apply with equal force here. There is no teaching or suggestion in FR 2 667 072 alone or in combination with EP 0 771 556 that tackiness could be reduced by incorporating a phospholipid into a cosmetic or dermatological preparation comprising chitosan. Consequently, the combination of FR 2 667 072 and EP 0 771 556 also does not make out a *prima facie* case of obviousness, and, therefore, the Examiner should withdraw this rejection as well. An early notice that this rejection has been reconsidered and withdrawn is, therefore, also earnestly solicited.

Early and favorable action is earnestly solicited.

Respectfully submitted,

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By



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